



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/557,744

12/11/2006

Diana Cheng

526801-56PUS

2291

27799

7590

07/09/2009

COHEN, PONTANI, LIEBERMAN & PAVANE LLP  
551 FIFTH AVENUE  
SUITE 1210  
NEW YORK, NY 10176

EXAMINER

CHOO, MUNSOON

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

07/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/557,744	<b>Applicant(s)</b> CHENG ET AL.	
	<b>Examiner</b> MUNSOON CHOO	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

***Note: The previous claim objections have been withdrawn.***

### ***Response to Arguments***

1. Applicant's arguments, with regards to claim 8 and 15 filed May 26, 2009 have been fully considered but they are not persuasive.
2. **On page 15 of the Applicant's Response, applicants argue** Shieh does not disclose in claim 8 that:
  - The SIM card does comprise the actual ESN or permanent account identifier
  - The S-ESN is prestored at the HLR or the MC
  - Wherein said one-time and permanent account identifier are prestored in said at least one remote system.
3. **The Examiner respectfully disagrees with Applicant's arguments.**

The SIM card does comprise the actual ESN or permanent account identifier

**(Abstract: In SIM based mobile device, the SIM card and the mobile device are incorporated with each other as a whole and said SIM based mobile device has the actual ESN)**

The S-ESN is prestored at the HLR or the MC

**(C3 L11-20: Generally, HLR stores SIM card detail (includes S-ESN) from the vendors)**

Art Unit: 2617

Wherein said one-time and permanent account identifier are prestored in said at least one remote system.

**(C3 L11-20: Generally, HLR stores SIM card detail from the vendors. Note: The vendors (have its SIM card detail) are also considered as remote system)**

4. **On page 17 of the Applicant's Response, applicants argue** Shieh does not disclose in claim 15 that:

- A remote system storing a one-time account identifier for a one-time logon of a subscriber identifying module to the network

5. **The Examiner respectfully disagrees with Applicant's arguments.**

(Shieh, abstract: The HLR or the SIM vendor should have SIM card detail (includes temporary ESN) stored in the database)

6. **Therefore, in view of the above reasons, Examiner maintains rejections.**

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2617

8. **Claim 8-14, and 20-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh et al. (Pat# 6,591,098 hereinafter "Shieh") in view of MCI Communications Corporation (Publish# WO 97/01253 hereinafter "MCI").

**Re claim 8**, Shieh discloses a subscriber identifying module including a microcontroller in a mobile telecommunication network which is configured to communicate with at least one remote system in the mobile communication network **(Abstract: A SIM card is inside a mobile device (SIM based mobile device). Said mobile device can communicate with the service provider (remote system) in the wireless network.)**, said subscriber identifying module and said remote system being adapted to store at least one parameter identifying a user in the network, **(Abstract: SIM card stores subscriber info (parameter) for activation over the air with remote system)** said subscriber identifying module comprising: **(Note: In abstract, the SIM card and mobile device are incorporated together as one object as a whole, and is regarded as SIM based mobile device)**

a one-time account identifier designed for a one-time logon to the network; and

**(Abstract: temporary activation identifiers, temporary electronic serial number).**

a permanent account identifier, said permanent account identifier being deactivated;

**(C3 L20-34: The actual electronic serial number (permanent account identifier) is currently deactivated until future registration. )**

wherein said one-time and permanent account identifier are prestored in said at least one remote system, **(C3 L11-20: The HLR (can store SIM card detail inherently) compares the temporary electronic serial number (ESN) from the mobile device to the electronic serial number from the associated vendor (could be Verizon vendor, which is remote system). For permanent account identifier, it follows the same reason above.)** and wherein said microcontroller is programmed to:

a) use the one-time account identifier to logon to the network when said subscriber identifying module is switched on;

**(Abstract: The temporary ESN. Fig5 ref 300)**

b) exchange the one-time account identifier with the permanent account identifier in the subscriber identifying module upon successful logon to the network as the active account identifier in a first data processing device; and

**(Abstract: Temporary activation identifier is overwritten (should be by the actual ESN))**

c) upon successful logon to the network, send an activation request (**abstract: over-the-air activation**) for deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module

Art Unit: 2617

Note: Shieh didn't specifically disclose: deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module

MCI discloses: deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module

**(MCI, abstract, Fig2: The replacement (new) card is fully activated, while the old (second) SIM card is disabled)**

Shieh discloses:

and activating the permanent account identifier attached to the first data processing device.

**(Shieh, Abstract: transmit its actual ESN to complete the activation process (for permanent account) with the SIM card)**

It would be obvious to one of ordinary skill in the art to modify Shieh, and have **disabling the old SIM card after the replacement SIM card is fully activated** as taught by MCI, thereby will replacement SIM card in the communication network as discussed by MCI.

**Re claim 9**, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the account identifier attached to the subscriber

Art Unit: 2617

identifying module identifies the same account as the account identified by the account identifier attached to a second data processing device.

**(MCI: abstract, note: the first device with the replacement SIM card (first SIM) will replace the second device with the old SIM card (second SIM). Therefore, the new SIM card will identify as the same account as the old SIM card.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the new SIM card replacing the mobile device with the old SIM card.

**Re claim 10**, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the permanent account identifier attached to the first subscriber identifying module identifies an account which is different from the account identified by the account identifier attached to the second data processing device.

**(MCI: page 1, under “Background of The Invention”. Note: A user with his individual SIM card (that has permanent account identified for him specifically) can freely use any available terminal (second data processing device) in the network. The newly chosen terminal by the user might have a previously stored account, which is different than the account identified in the user’s SIM card.**



Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of inserting the user's SIM card into a mobile terminal, and causes the mobile terminal to function according to the account identifier of the user's SIM card.

**Re claim 11**, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the first subscriber identifying module stores the account identifier attached to the second subscriber identifying module

**(MCI: abstract, note: the first device with the replacement SIM card (first SIM) will replace the second device with the old SIM card (second SIM). Therefore, the new SIM card will identify as the same account as the old SIM card and would store the account identifier attached to the second subscriber identifying module. Also, The HLR and AuC will correlate an identifier of the replacement SIM card with an identifier of the original SIM card.)**

and the first subscriber identifying module is programmed for transmitting said account identifier attached to the second subscriber identifying module to the said at least one remote system.

**(MCI: abstract, note: "Upon first use of the replacement SIM (first subscriber identifying module) card, the network disables the original identifier (second**

Art Unit: 2617

**subscriber identifying module) in the HLR (remote system) and AuC (remote system).**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the replacement SIM card logged onto the network, having the HLR and AuC correlate the identifier of the replacement SIM card with the identifier of the original SIM card, and at the end, enabling the replacement SIM card and disabling the original SIM card.

**Re claim 12**, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein said subscriber identifying module is a SIM card.

**(Shieh: abstract)**

**Re claim 13**, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the logon step a) is performed in a centralized remote system

**(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)**

and after receiving the activation request from said device,

**(Shieh: Abstract, note: A SIM-over –the-air-activation processor is notified to perform the activation for the mobile device.)**

said centralized remote system sends commands to said at least one remote system

**(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.**

**MCI: Figure 1 reference 18 (telephony switches) is the centralized remote system that allows communication access between mobile equipments (ME reference 12) and remote system of HLR 20, AuC 22 and Customer Support Center 24.**

for exchanging the current active account corresponding to a second data processing device into the new active account corresponding to the first data processing device.

**(MCI: abstract, note: Upon first use of the replacement SIM card, the network disables the original identifier in the HLR and AuC so that subsequent access is solely available to the replacement SIM card. Therefore, the replacement SIM card (as for first device) has taken over the active account of the old SIM card (previously or current active account correspond to the second device.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

**Re claim 14**, Shieh and MCI as a whole disclose the subscriber identifying module of claim 8, wherein the step b) is performed in said first data processing device by means of an auto-activation application executed

**(Shieh: abstract, note: A SIM-over-the-air activation processor is notified to perform the activation for that mobile device, and this is an auto-activation.)**

after receiving a message from the network informing a successful logon.

**(Shieh: abstract, note: The network identifies the temporary electronic serial number associated with the SIM vendor (when successful) and invokes an over-the-air activation procedure)**

**Re claim 20**, Shieh discloses a method for activating a subscriber identifying module in a telecommunication network, said method comprising the steps of:

**(Shieh: Abstract)**

providing a first subscriber identifying module which stores a one-time account identifier designed for a one-time logon to the network and which also stores a permanent account identifier, said permanent account identifier being deactivated,

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number that is used in the registration and activation process (one-time usage). )**

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial number (permanent account identifier) to the mobile device for**

Art Unit: 2617

**future registration. The actual electronic serial number is currently deactivated until future registration.)**

said first subscriber identifying module being programmed to, upon successful one-time logon to the network, exchange the one-time account identifier with the permanent account identifier in said first subscriber identifying module

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44.**

**Before the final step, the network identifies the SIM electronic serial number as the temporary ESN associated with the mobile device, therefore, using the temporary ESN as the active account identifier, the mobile device is successfully logged on to the network.**

**Note: Finally, to complete the over-the-air-activation process, the method comprises setting the usage indicators to transmit the actual ESN in the future and overwriting the temporary activation identifiers. )**

and send an activation request to a remote network system for activating said permanent account identifier attached to a first data processing device; and

**(Shieh: Column 5 line 39 to 46, column 5 line 62 to column 6 line 4. Note: HLR 118 or MC 116 transmit activation notification to SIM-over-the-air-activation processor (SOTAP) to let SOTAP know that an OAA process should be initiated on a registering SIM mobile device.); Abstract, note: The temporary electronic serial number is used when requesting activation for the mobile device (first data**

Art Unit: 2617

**processing device). Once the activation is completed, the actual electronic serial number (permanent account identifier attached to the mobile device) will be used for future registrations.; (Column 3 lines 31 to 34: To complete the over-the-air-activation, the actual ESN will overwrite the temporary activation identities.)**

However, Shieh fails to disclose:

Providing a remote network system which stores an active account identifier attached to a second subscriber identifying module,

said remote network system being programmed for treating the activation request originating from the first subscriber identifying module by the operations which include deactivating the account identifier attached to the second original subscriber identifying module and activating the account identifier attached to the first subscriber identifying module. MCI does.

**(MCI: Abstract, note: Disable (deactivate) the old SIM (second SIM) and enabling the replacement SIM (first SIM))**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of enabling the replacement SIM in the network, and disabling the old SIM in the network.

**Re claim 21**, Shieh discloses a data processing device including a microcontroller and configured to communicate with at least one remote system distributed on a network,  
said data processing device and said remote system adapted to store a plurality of parameters identifying a user account belonging to a subscriber

**(Shieh: Abstract, column 1 lines 20 to 32. Note: A subscriber identification module (SIM) is inside a mobile device. Said mobile device is able to communicate with the service provider (remote system) in the wireless network. Said service provider enters activation data (parameter) into the wireless network related to the individual and the mobile device identification, and therefore, the wireless network will recognize the user and mobile device.)**

said data processing device comprising:

a one-time parameter comprising the active account attached to said data processing device designed for a one-time use; and

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number (parameter) that is used in the registration and activation process (one-time usage as an active account).**

a permanent parameter identifying an account attached to said data processing device,  
said permanent parameter being deactivated;

Art Unit: 2617

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial number (permanent account identifier) to the mobile device for future registration. The actual electronic serial number is currently deactivated until future registration. Column 3 lines 31 to 34: To complete the over-the-air-activation, the actual ESN will overwrite the temporary activation identities.)**

wherein said one-time and permanent parameter are stored in said at least one remote system,

**(Shieh: Column 3 lines 11 to 20, column 5 lines 39 to 46, claim# 16. Note: The HLR (remote system) compares the temporary electronic serial number (one-time account identifier) from the mobile device to the electronic serial number from the associated vendor. Thus, the temporary electronic serial number is pre-stored in the remote system. In column 2 lines 59 to 61, the network identifies the manufacture of the SIM card for specifications. The actual ESN number (permanent account identifier) is inherently stored in the associated vendor. )**

And wherein said microcontroller is programmed to:

a) Using the one-time parameter to logon to the network when said data processing device is switched on; and

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: During registration, the mobile device transmits the activation identifier and the SIM**



Art Unit: 2617

**electronic serial number as the card identifier to the wireless network. The mobile device is turned on during registration.**

**The S-ESN is a temporary electronic serial number, which is a parameter.)**

b) Exchanging the one-time parameter with the permanent parameter, upon successful logon to the network,

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44.**

**Before the final step, the network identifies the SIM electronic serial number as the temporary ESN associated with the mobile device, therefore, using the temporary ESN as the active account identifier, the mobile device is successfully logged on to the network.**

**Note: Finally, to complete the over-the-air-activation process, the method comprises setting the usage indicators to transmit the actual ESN in the future and overwriting the temporary activation identifiers.**

**The actual electronic serial number (ESN) is the parameter for permanent active account because it will overwrite the temporary activation identifiers and become useful for the future. )**

said permanent parameter becoming the permanent active account,

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44.**

Art Unit: 2617

**The actual electronic serial number (ESN) is the parameter for permanent active account because it will overwrite the temporary activation identifiers and become useful for the future. )**

However, Shieh fails to disclose:

wherein a first data processing device and said at least one remote system store a parameter identifying a current active account attached to a second data processing device to replace,  
and upon successful logon to the network,  
a program automatically stored in said first data processing device sends an activation request for  
exchanging the plurality of parameters from the old for the new one in said at least one remote system,  
with the current active account being deactivated.

MCI discloses:

wherein a first data processing device and said at least one remote system store a parameter identifying a current active account attached to a second data processing device to replace,

**(MCI: Abstract, note: [First device has replacement SIM, since it will replace the old SIM card, it has the parameter identifying the current active account of the**

Art Unit: 2617

**second data processing device (with old SIM) and the HLR and AuC (Remote system) has parameter for the current active account for the second data processing device (to be replaced) because HLR and AuC will be correlated by administrator. The second data processing device is the device that uses the old SIM card, and will be replaced. )**

and upon successful logon to the network,

a program automatically stored in said first data processing device sends an activation request for

**(MCI: figure 2, note: “Replacement SIM card Fully activated”.**

**Abstract: Authentication Center (AuC) is for activation.)**

exchanging the plurality of parameters from the old for the new one in said at least one remote system,

**(MCI: abstract, note: The replacement (new SIM card) SIM card will take over the parameters (subscriber’s detail) from the old SIM card.**

**Page 5 line 9, page 3 line 6 to 8 mention repeated rewriting of data to memory,**

**which shows the functionality of exchanging data or parameters.)**

with the current active account being deactivated.

**(MCI: abstract, note: disabling the old SIM card will deactivate the current active account)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of enabling the replacement SIM card, disabling the old SIM card in the network, and have the replacement SIM card replaces the old SIM card by copying the subscriber's detail from the old SIM card to the replacement SIM card.

**Re claim 22**, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein said activation request includes

at at least one of at least one old parameter and at least one new parameter

**(Shieh: abstract, note: The temporary electronic serial number associated with the SIM vendor is a new parameter for the network.)**

for identifying the device requesting an account activation

**(Shieh: abstract.)**

**Re claim 23**, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein said one-time parameter is the same for a set of data processing devices replacing a respective old data processing device.

**(Shieh: abstract, note: the one-time parameter could be an international mobile station identity (IMSI) and/or mobile identification number (MIN), and a temporary electronic serial number. MIN is a parameter, which is accompanied by a value (number).)**

Art Unit: 2617

**(MCI: abstract. Note: When the replacement SIM card is inserted into any available terminal, its IMSI parameter will be the same for any of the chosen terminal.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the replacement SIM card includes identifying parameters such as IMSI, MIN or temporary electronic serial number, and having any mobile terminal in the network capable of transmitting value of these parameters to the telephony switches or to the remote system.

**Re claim 24**, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein the subscriber switches on said data processing device.

**(Shieh: column 1 lines 40 to 49, note: when a mobile device is first used (it is switched on by said subscriber))**

**Re claim 25**, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein after receiving the activation request from said first data processing device,

**(Shieh: Abstract, note: A SIM-over –the-air-activation processor is notified to perform the activation for the mobile device.)**

A centralized remote system sends commands to said at least one remote system

Art Unit: 2617

**(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)**

**(MCI: Figure 1 reference 18 (telephony switches) is the centralized remote system that allows communication access between mobile equipments (ME reference 12) and remote system of HLR 20, AuC 22 and Customer Support Center 24.**

for exchanging the current active account corresponding to the second data processing device into the new active account corresponding to the first data processing device.

**(MCI: abstract, note: Upon first use of the replacement SIM card, the network disables the original identifier in the HLR and AuC so that subsequent access is solely available to the replacement SIM card. Therefore, the replacement SIM card (as for first device) has taken over the active account of the old SIM card (previously or current active account correspond to the second device.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

**Re claim 26**, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein the logon step a) is performed in a centralized remote system

Art Unit: 2617

**(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)**

and after receiving the activation request from said first data processing device,

**(Shieh: Abstract, note: A SIM-over –the-air-activation processor is notified to perform the activation for the mobile device.)**

said centralized remote system sends commands to said at least one remote system

**(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)**

**(MCI: Figure 1 reference 18 (telephony switches) is the centralized remote system that allows communication access between mobile equipments (ME reference 12) and remote system of HLR 20, AuC 22 and Customer Support Center 24.**

for exchanging the current active account corresponding to the second data processing device into the new active account corresponding to the first data processing device.

**(MCI: abstract, note: Upon first use of the replacement SIM card, the network disables the original identifier in the HLR and AuC so that subsequent access is solely available to the replacement SIM card. Therefore, the replacement SIM card (as for first device) has taken over the active account of the old SIM card (previously or current active account correspond to the second device.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

**Re claim 27**, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein the step b) is performed in said device by means of an auto-activation application executed

**(Shieh: abstract, note: A SIM-over-the-air activation processor is notified to perform the activation for that mobile device, and this is an auto-activation.)**

after receiving a message from the network informing a successful logon.

**(Shieh: abstract, note: The network identifies the temporary electronic serial number associated with the SIM vendor (when successful) and invokes an over-the-air activation procedure)**

9. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh and in view of Shannon et al. (Patent# 6,285,869 hereinafter "Shannon").

**Re claim 15**, Shieh discloses a remote telecommunication system in a mobile telecommunication network, wherein the remote telecommunication system is configured for communicating with a subscriber identifying module, said remote telecommunication system storing:



Art Unit: 2617

**(Shieh: Abstract, column 1 lines 20 to 32. Note: A subscriber identification module (SIM) is inside a mobile device. Said mobile device is able to communicate with the service provider (remote system) in the wireless network.)**

a one-time account identifier for a one-time logon of a subscriber identifying module to the network

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number that is used in the registration and activation process (one-time usage).**

a permanent account identifier attached to an original data processing device; and

**(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial number (permanent account identifier) to the mobile device (data processing device) for future registration.)**

However, Shieh fails to disclose:

a set of instructions for accepting logon of a replacement subscriber identifying module in the network

and treating an activation request from the replacement subscriber identifying module by the following operations:

deactivating the account identifier attached to the original subscriber identifying module

Art Unit: 2617

and, activating the account identifier attached to the replacement data processing device.

Shannon discloses a set of instructions for accepting logon of a replacement subscriber identifying module in the network

**(Shannon: Column 2 line 51-59, note: From time to time, this card requires replacement. The system of figure 1 is a network system.)**

and treating an activation request from the replacement subscriber identifying module by the following operations:

(Shannon: abstract)

deactivating the account identifier attached to the original subscriber identifying module

(Shannon: abstract)

and, activating the account identifier attached to the replacement data processing device.

(Shannon: abstract)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and Shannon as a whole to produce the invention as claimed with a reasonable expectation of enabling the replacement SIM in the network, and disabling the old SIM in the network.

Art Unit: 2617

10. Claims **16-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh and Shannon as applied to claim 15 above, and further in view of MCI.

**Re claim 16**, Shieh and Shannon as a whole disclose the remote telecommunication system according to claim 15, but fails to disclose wherein the remote telecommunication system is programmed for associating the account identifier attached to the original subscriber identifying module with the same account as the account identified by the account identifier attached to the replacement data processing device. However, MCI does.

**(MCI: abstract, note: the first device with the replacement SIM card (new SIM) will replace the second device with the old SIM card (original SIM). Therefore, the new SIM card will identify as the same account as the old SIM card.**

**Note: “Administrator to correlate (associate) an identifier of the replacement SIM card with an identifier of the original SIM card”).**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

**Re claim 17**, Shieh and Shannon as a whole disclose the remote telecommunication system according to claim 15, but fails to disclose wherein the remote telecommunication system is programmed for associating the permanent account identifier attached to the first subscriber identifying module to an account which

Art Unit: 2617

is different from the account identified by the account identifier attached to the second data processing device. However, MCI does.

**(MCI: page 1, under “Background of The Invention”. Note: A user with his individual SIM card (that has permanent account identified for him specifically) can freely use any available terminal (second data processing device) in the network. The newly chosen terminal by the user might have a previously stored account, which is different than the account identified in the user’s SIM card. As for associating the user’s SIM card account to the account attached to the second data processing device: Since the user can freely use any terminal in the network, then after the user chooses a terminal by inserting his SIM card into the chosen terminal, the network will associate the user’s SIM card with said chosen terminal.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI as a whole to produce the invention as claimed with a reasonable expectation of the user inserting his SIM card into the mobile terminal and he can start using the mobile terminal as his mobile phone.

**Re claim** 18, Shieh and Shannon as a whole disclose the remote telecommunication system according to claim 15, but fails to disclose wherein the remote system determines the account identifier to be deactivated from the account identifier attached to the second processing device as transmitted by the first data

processing device. However, MCI does.

**(MCI: Abstract, note: The old SIM card (for the second processing device) is to be deactivated, when the replacement SIM card (for the first data processing device) uses the network for the first times.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card, therefore, enabling the replacement SIM card and disabling the original SIM card in the network.

**Re claim 19**, Shieh and Shannon as a whole disclose the remote telecommunication system according to claim 15, but fail to disclose wherein the one-time account identifier **(Shieh: abstract, note: the one-time parameter could be an international mobile station identity (IMSI) and/or mobile identification number (MIN), and a temporary electronic serial number. MIN is a parameter, which is accompanied by a value (number))** is the same for a set of data processing devices in the network. MCI does.

**(MCI: abstract. Note: When the replacement SIM card is inserted into any available terminal, its IMSI parameter (one-time parameter) will be the same for**

**any of the chosen terminal. Please also note that Shieh points out that IMSI could be considered as one-time parameter.)**

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the replacement SIM card includes identifying parameters such as IMSI, MIN or temporary electronic serial number, and having any mobile terminal in the network capable of transmitting value of these parameters to the telephony switches or to the remote system.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2617

### **Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUNSOON CHOO whose telephone number is (571)270-7140. The examiner can normally be reached on Monday through Friday 7:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571)272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Munsoon Choo/

Examiner, Art Unit 2617

/NICK CORSARO/

Supervisory Patent Examiner, Art Unit 2617